

**Remarks/Arguments****I. Response to Rejections under 35 USC Section 103(a):**

The Applicant respectfully requests that the Examiner consider the amended claims and the following remarks and arguments. These are presented in response to the Examiner's recent combination of the "Braun" (US 4,621,319), "Cai" (US 6,631,474), "Sellers" (US publication 20010019639), and "Cheng" (US publication 20020066048) references. The combination of these references was made for the first time in the Examiner's Final Rejection of the claims mailed August 5th, 2004.

At page 5, item 6 of the Office Action, claims 3, 9, 15, and 20 are rejected as being unpatentable over the aforementioned combination of "Braun" (US 4,621,319), "Cai" (US 6,631,474), "Sellers" (US publication 20010019639), and "Cheng" (US publication 20020066048). The Applicants respectfully traverse this rejection since the Examiner has not presented prima facie motivation to the combine the references. More particularly, at paragraph 3 of item 6 of the Office Action, the Examiner alleges that:

"it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Braun and Cai, and Sellers *because the teachings of Cheng stated above would improve the functionality of the Braun system. Since a graphical pointing device is one of the widely used input devices in a portable computer and Cheng's input device provides a way for a keyboard controller to receive inputs from it.*" [Italics added by Applicant]

The Applicants respectfully assert that for the Examiner to allege that these references represent a proper combination *simply because the teachings of Cheng would improve the functionality of Braun* is without merit. The Applicants assert there are literally thousands of teachings in thousands of publications that could "improve" the functionality of Braun. Further, the assertion that "*Since a graphical pointing device is one of the widely used input devices in a portable computer*", is equally improper. The Applicants respectfully assert that simply because a graphical pointing device is

“widely used” does not render the combination proper.

The Applicants assert that the Examiner’s rationale for the combination of references is based on hindsight and is not due to the presence of some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. In other words, the knowledge required to make this combination has come from the Applicants’ invention.

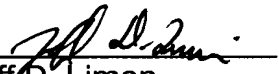
To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion, or reason to combine cited references.” Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar “...**the opportunity to judge by hindsight is particularly tempting**. Consequently, the tests of whether to combine references need to be applied **rigorously**.” McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added].

As the foregoing amendments to the claims do not raise new issues, it is the Applicant’s position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered and allowed despite the finality of the present rejection. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant’s agent at (541) 715-5979 if the Examiner has any questions or concerns.

**II. Additional Fees:**

It is not believed that additional fees are due at this time; however, if any additional fee is required in connection with the filing of this Amendment, please charge the fee to Deposit Account No. 08-2025.

Respectfully Submitted,  
Weng Wah Loh et al.

By:   
Jeff D. Limon  
Agent for the Applicants  
Registration Number 45,418

Hewlett-Packard Company  
Legal Department  
1000 NE Circle Blvd.  
Corvallis, OR 97330  
Telephone: (541) 715-5979  
Fax: (541) 715-8581